REMARKS/ARGUMENTS

Upon entry of the present amendment, claims 13, 15, 16, and 18 will have been amended, and new claims 19-26 will have been submitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding objections and rejection of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on December 1, 1999, June 14, 2000, January 9, 2001, and June 24, 2002 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has objected to claims 13, 16, and 18 because of informalities. By the present amendment, Applicant has corrected these informalities. Thus, Applicant respectfully requests that the Examiner withdraw the objection.

The Examiner has rejected to claims 13-18 under 35 U.S.C § 103 (a) as being unpatentable over OHNISHI et al. (U.S. Patent No. 5,655,152) and further view of OHTO et al. (U.S. Patent 5,864,673).

As noted above, Applicant has amended claims 13, 15, 16, and 18 and has newly submitted claims 19-26 for reconsideration. Applicant respectfully traverses the above rejection based on these amended claims 13-26 and will discuss the rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the canceled claims, but do not raise new issues.

Applicant's claims 13-15, 19-21, and 26 relate to an image communication apparatus connected with a receiving facsimile via a server apparatus on the Internet. The image communication apparatus is configured to communicate with a first server apparatus and with a second server apparatus. The image communication apparatus also has a controller which accesses the first server apparatus to obtain capabilities regarding facsimile data that the receiving facsimile can receive. Further, the controller obtains, from the second server apparatus, the capabilities regarding facsimile data that the receiving facsimile can receive, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving facsimile can receive, transforms image data, based on the obtained capabilities regarding facsimile data that the receiving facsimile can receive, converts the transformed image data into data for Internet transmission, and transmits the converted data to the receiving facsimile. Claims 18 and 23-25 recite related methods.

Applicant's claims 16-17 and 22 relate to a server apparatus having a memory and connected with a transmitting facsimile and a receiving facsimile via the Internet. The server apparatus, *inter alia*, obtains the capabilities of the receiving facsimile from another server apparatus that stores the capabilities of the receiving facsimile, when the capabilities of the receiving facsimile are not stored in the memory and when the transmitting facsimile inquires regarding the capabilities of the receiving facsimile, and transmits the capabilities of the receiving facsimile to the transmitting facsimile. Thus, the transmitting facsimile is able to transform image data, based on the capabilities of the receiving facsimile, to convert the transformed image data into data for Internet transmission, and to transmit the converted data to the receiving facsimile.

On the contrary, Fig. 21 of OHNISHI et al. disclose a system in which a server 30 is connected to a printer 22 and a facsimile 24, and is connected to a client 25. The server 30 is also connected to a server 31 and to a server 32. The server 31 and the server 32 can send job requests to the printer 22 (or the facsimile 24), which is connected to the server 30. Similarly, the client 25, connected to the server 30, can send a job request to the servers 31 and 32 to use output units (not-illustrated), which are connected to the servers 31 and 32 (see column 27, line 42-63 of OHNISHI et al.). When the server 30 receives a job request from another server 31 (or 32), the server 30 selects an adequate output unit (the printer 22 or the facsimile 24), based on the job request (see column 27, line 64-67; column 28,

lines 1-25 of OHNISHI et al.). Similarly, when the client 25 sends a job request to an output unit (i.e., a printer) which is connected to another server 31 (or 32) via the server 30, the other server 31 (or 32) selects an adequate output unit (i.e., a printer) which is connected to the other server 31 (or 32), based on the job request (see column 28, lines 26-62 of OHNISHI et al.). In other words, in OHNISHI et al., a respective server selects an adequate output unit (a printer or a facsimile), which is connected thereto, based on a job request from a client connected thereto or another server.

However, the present invention does not select an adequate receiving facsimile connected to a server apparatus, based on a job request, but the present invention obtains, from the server apparatus, capabilities regarding facsimile data that the receiving facsimile can receive, and transforms image data, based on the capabilities regarding facsimile data that the receiving facsimile can receive. In other words, OHNISHI et al. merely selects an adequate output unit connected to a server. Thus, OHNISHI et al. does not disclose a facsimile which obtains from the server apparatus capabilities regarding facsimile data that the receiving facsimile can receive, and transforms image data based on the capabilities regarding facsimile data that the receiving facsimile can receive.

Further, OHNISHI et al. merely selects an adequate output unit connected to a server other than the server connected to the client. Thus, OHNISHI et al. does not disclose a transmitting apparatus which obtains from the second server

apparatus the capabilities regarding facsimile data that the receiving facsimile can receive, when the first server apparatus is determined not to store the capabilities of the receiving facsimile, and stores, in the first server apparatus, the obtained capabilities regarding facsimile data that the receiving facsimile can receive.

Moreover, the eleventh embodiment of OHNISHI et al. teaches another system in which a server 53 receives a job request from a client or another server. The job request includes a data-output condition identifier exhibiting "resolution", as shown in Fig. 45(a). The server 53 stores a correspondence table for the data-output condition, as shown in Fig. 45(b). The server 53 selects an available output unit, based on the job request, by comparison with the correspondence table, and a higher priority is given to an output unit having higher resolution. Thus, the server 53 selects an output unit having higher resolution, when it selects the available output unit (see, column 39, lines 64-67; column 40, lines 50-65 of OHNISHI et al.). However, in OHNISHI et al., the data-output condition "resolution" is utilized for selecting the adequate output unit but is not utilized for transforming image data, based on the capabilities regarding facsimile data that the receiving facsimile can receive, as recited in the pending claims. Further, the present invention utilizes the capabilities obtained from either one of two servers, whereas in OHNISHI et al. since "resolution" is contained in the job request (see, Fig. 45(a)) and is stored in the server (see, Fig. 45(b)), only a single server is involved with "resolution." Moreover, the feature of "when the first server apparatus is determined not to store

the capabilities" is irrelevant to the OHNISHI et al. apparatus, since the job request contains the relevant data and information. Thus, OHNISHI et al. does not disclose the features of the pending claims.

In addition, in the present invention, the image communication apparatus (the transmitting apparatus) determines the receiving facsimile (the receiving apparatus), while, in OHNISHI et al., not the client (the transmitting apparatus) but the server determines the adequate output unit (the receiving apparatus), based on the job request from the client.

Therefore, it is respectfully submitted that numerous features recited in Applicant's claims 13-25 are not disclosed in OHNISHI et al. as cited by the Examiner.

OHTO et al. relates to a terminal device and a relaying device that transmits a multimedia document consisting of different media attributes, such as audio data, character data, still image data, motion picture, and hand-written data. The terminal device communicates not only with a facsimile but also with a telephone, a digital mobile telephone, PHS, and so on. Further, the terminal device 3001 of OHTO et al. has a media attribute-classified compression information storage unit 3003 (Fig. 30 of OHTO et al.). The media attribute-classified compression information storage unit 3003 stores a media attribute-classified compression information 3301, as shown in Fig.33.

However, the terminal device of OHTO et al. cannot obtain from a server apparatus the capabilities regarding facsimile data that the receiving facsimile can receive, since OHTO et al. merely discloses a destination terminal device which stores the media attribute-classified compression information, but do not disclose a server apparatus which stores capabilities regarding facsimile data that the receiving facsimile can receive. Thus, OHTO et al. do not disclose an image communication apparatus which obtains, from the server apparatus, capabilities regarding facsimile data that the receiving facsimile can receive, and transforms image data, based on the capabilities regarding facsimile data that the receiving facsimile can receive.

Further, since OHTO et al. does not disclose the above server apparatus which stores capabilities regarding facsimile data that the receiving facsimile can receive, OHTO et al. also do not disclose the claimed second server apparatus which stores the capabilities regarding facsimile data that the receiving facsimile can receive, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving facsimile can receive. Thus, OHTO et al. does not disclose an image communication apparatus which obtains from the second server apparatus the capabilities regarding facsimile data that the receiving facsimile can receive, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving facsimile can receive, and stores the obtained capabilities regarding facsimile data that the

receiving facsimile can receive. Thus, OHTO et al. also does not disclose features of the present invention,

Therefore, it is respectfully submitted that the features recited in Applicant's claims 13-25 are not disclosed in OHTO et al. cited by the Examiner. The pending claims are submitted to be patentable over the Examiner's proposed combination, since neither OHNISHI et al. nor OHTO et al. discloses the combination of features recited in Applicant's claims 13-25.

Additionally, there is no proper motivation for the proposed combination. The Examiner's assertion that since both OHNISHI et al. and OHTO et al. are from the same field of endeavor is insufficient to support a rejection under 35 U.S.C § 103(a). In order for a combination to be proper, the Examiner must provide a motivation for the proposed modification.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims and has submitted new claims for consideration by the Examiner.

With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the pending claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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